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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,332	04/14/2004	Alan L. Backus	65474-5002	5410

7590 07/12/2005

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EXAMINER	
DEL SOLE, JOSEPH S	

ART UNIT	PAPER NUMBER
1722	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/824,332	BACKUS ET AL.	
	Examiner	Art Unit	
	Joseph S. Del Sole	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-62* is/are pending in the application.

4a) Of the above claim(s) *55-62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 55 -62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/31/05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15-22, 31-33, 36-43 and 52-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original specification does not disclose the first plate and the second plate being free of liquid lubricants during operation of the device, as recited in claims 15-16 and 38-39, and thus is new matter.

The original specification does not disclose the second plate having depressions or having concentric depressions, as recited in claims 17-19 and 42-44, and thus is new matter.

The original specification does not disclose the first plate being made of metal, as recited by claims 20 and 41, and thus is new matter.

The original specification does not disclose the second plate being made of plastic, as recited by claims 21 and 42, and thus is new matter.

The original specification does not disclose the first plate being made of metal and the second plate being made of plastic, as recited by 22 and 43, and thus is new matter.

The original specification does not disclose the housing being essentially can shaped and the thrust bearing being disposed in the bottom of the can, the can shaped housing protruding into the container, or the can shaped housing being capped by and extrusion die, as respectively recited by claims 31-35 and 52-54, and thus is new matter.

If applicants disagree that such matter is new matter, applicants should show support for such subject matter in the ORIGINAL specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 13-16, 21, 24-37, 42 and 45-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (4,406,603).

Williams discloses a device, that corresponds to the instant device, for making pasta from pasta making ingredients including a container, 24, 28 housing pasta making ingredients, an essentially cylindrical housing 58 containing a driven auger screw 60 which conveys pasta making ingredients out from the container, 24, 28 when the screw 60 is driven, and a thrust bearing, the thrust bearing having a first plate and a second plate, the first and second plates accepting thrust loads from the auger screw when the auger screw is driven, the first plate rotating with the auger screw when the auger screw is driven and the second plate not rotating with the auger screw when the auger screw is driven (see Fig 6). As shown in Fig. 6, the first plate is attached to the screw 60 no a screw end opposite to a die 70, the second plate closes the housing 58 on a housing end opposite to the die 70, the first and second plates are in contact with the pasta making ingredients, the first and second plates are free of liquid lubricants during operation of the device, the thrust bearing is disposed within the housing 58, the thrust bearing is located at one end of the screw 60 and the opposite end of the screw is contacted by the die 70, the housing 58 is essentially can shaped and the thrust bearing is disposed in the bottom of the can, the can shaped housing 58 protrudes into the container 24, 28, and the can shaped housing is capped by the extrusion die 70. The screw is driven by an electric motor (see cols, 4 and 7). The screw 60 including the first plate and the housing 58 are made of plastic (co 8, lines 3-26).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 20, 22, 23, 41, 43 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (4,406,603).

Williams disclose the device substantially as claimed except for the materials being metal. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the materials to be metal because mere selection of

known materials, (i.e., stainless steel) on the basis of suitability for the intended use would be entirely obvious, In re Leshin, 125 USPQ 416.

Double Patenting

10. Applicant is advised that should claim 14 be found allowable, claims 27-30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Also, Applicant is advised that should claim 35 be found allowable, claims 48-51 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 14 and 35 already recite that the structure of the first and second plate is such that the ingredients contact them during operation of the device. Claims 27-30 and 48-51 only further recite the materials used by the claimed apparatus and thus are no different in structure or structural relationship than claims 14 and 35, respectively. Intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re Finsterwalder, 168 USPQ 530. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, Ex parte Thibault, 164 USPQ 666. Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, In re Otto et al., 136 USPQ 458. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus satisfying the structural limitation of that claimed, Ex parte Masham, 2 USPQ 2d 1647. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, In re Casey, 152 USPQ 235.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 13 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 respectively of U.S. Patent No. 6,743,007. Although the conflicting claims are not identical, they are not patentably distinct from each other because each element claimed by the Applicant is positively recited in the claims of the cited Patent.

13. Claims 13, 17, 18, 19, 34, 38, 39 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 1, 5, 1, 5, 1, and 5 respectively of U.S. Patent No. 6,280,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because each element claimed by the Applicant is positively recited in the claims of the cited Patent.

14. Claims 13, 17, 18, 19, 34, 38, 39 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 1, 2, 2, 3, 3, 4 and 4 respectively of U.S. Patent No. 6,743,007 in view of claims 1, 5, 5, 5, 1, 5, 5 and 5 respectively of U.S. Patent No. 6,280,092. The cited claims of 6,743,007 teach the invention as discussed previously and further teach concentric depressions on a first plate. The cited claims of 6,743,007 teach a second plate but fail to teach the second plate having concentric depressions. The cited claims of 6,280,092 teach a pasta maker having a second plate with concentric depressions.

15. Claims 13-16, 20-37, 41-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,743,007 in view of Williams (4,406,603). Claims 1 and 3 teach the apparatus as discussed above, but fails to teach the plates being free of liquid lubricants, the plates made of metal or plastic, the screw being driven by an electric motor, the thrust bearing disposed within the housing and located at one end of the auger screw and the opposite end of the auger screw contacted by an extrusion die, the housing being can shaped and protruding into the container, the can being capped by the extrusion die.

Williams discloses a device, that corresponds to the instant device, for making pasta from pasta making ingredients including a container, 24, 28 housing pasta making ingredients, an essentially cylindrical housing 58 containing a driven auger screw 60 which conveys pasta making ingredients out from the container, 24, 28 when the screw 60 is driven, and a thrust bearing, the thrust bearing having a first plate and a second

plate, the first and second plates accepting thrust loads from the auger screw when the auger screw is driven, the first plate rotating with the auger screw when the auger screw is driven and the second plate not rotating with the auger screw when the auger screw is driven (see Fig 6). As shown in Fig. 6, the first plate is attached to the screw 60 no a screw end opposite to a die 70, the second plate closes the housing 58 on a housing end opposite to the die 70, the first and second plates are in contact with the pasta making ingredients, the first and second plates are free of liquid lubricants during operation of the device, the thrust bearing is disposed within the housing 58, the thrust bearing is located at one end of the screw 60 and the opposite end of the screw is contacted by the die 70, the housing 58 is essentially can shaped and the thrust bearing is disposed in the bottom of the can, the can shaped housing 58 protrudes into the container 24, 28, and the can shaped housing is capped by the extrusion die 70. The screw is driven by an electric motor (see cols, 4 and 7). The screw 60 including the first plate and the housing 58 are made of plastic (co 8, lines 3-26).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of the claims of 6,743,007 with the features of Williams because such features are necessary for a complete construction of a pasta making apparatus.

Williams disclose the device substantially as claimed except for the materials being metal. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the materials to be metal because mere selection of

known materials, (i.e., stainless steel) on the basis of suitability for the intended use would be entirely obvious, In re Leshin, 125 USPQ 416.

16. Claims 13-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,743,007 in view of Williams (4,406,603). Claims 1 and 5 teach the apparatus as discussed above, but fails to teach the plates being free of liquid lubricants, the plates made of metal or plastic, the screw being driven by an electric motor, the thrust bearing disposed within the housing and located at one end of the auger screw and the opposite end of the auger screw contacted by an extrusion die, the housing being can shaped and protruding into the container, the can being capped by the extrusion die.

Williams discloses a device, that corresponds to the instant device, for making pasta from pasta making ingredients including a container, 24, 28 housing pasta making ingredients, an essentially cylindrical housing 58 containing a driven auger screw 60 which conveys pasta making ingredients out from the container, 24, 28 when the screw 60 is driven, and a thrust bearing, the thrust bearing having a first plate and a second plate, the first and second plates accepting thrust loads from the auger screw when the auger screw is driven, the first plate rotating with the auger screw when the auger screw is driven and the second plate not rotating with the auger screw when the auger screw is driven (see Fig 6). As shown in Fig. 6, the first plate is attached to the screw 60 no a screw end opposite to a die 70, the second plate closes the housing 58 on a housing end opposite to the die 70, the first and second plates are in contact with the pasta making ingredients, the first and second plates are free of liquid lubricants during

operation of the device, the thrust bearing is disposed within the housing 58, the thrust bearing is located at one end of the screw 60 and the opposite end of the screw is contacted by the die 70, the housing 58 is essentially can shaped and the thrust bearing is disposed in the bottom of the can, the can shaped housing 58 protrudes into the container 24, 28, and the can shaped housing is capped by the extrusion die 70. The screw is driven by an electric motor (see cols, 4 and 7). The screw 60 including the first plate and the housing 58 are made of plastic (co 8, lines 3-26).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of the claims of 6,280,092 with the features of Williams because such features are necessary for a complete construction of a pasta making apparatus.

Williams disclose the device substantially as claimed except for the materials being metal. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the materials to be metal because mere selection of known materials, (i.e., stainless steel) on the basis of suitability for the intended use would be entirely obvious, In re Leshin, 125 USPQ 416.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, Mr. Duane Smith can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

Joseph S. Del Sole
July 11, 2005